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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/349,676	07/08/1999	KRISTEN DIANE ONDECK	PHA-23.681	6934

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Corporate Patent Counsel  
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EXAMINER

JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 10/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/349,676

Applicant(s)

ONDECK, KRISTEN DIANE

Examiner

Jean D Janvier

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 August 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### Response To Arguments

Applicant argues that **Lemole does not mention customizing equipment of the customer**. The Examiner respectfully disagrees with the Applicant's findings. First of all, the phrase **customizing equipment of the customer**, as recited in controlling claim 1, is broad and vague and therefore, claim 1 does not provide ground for patentability. Although the Examiner does not raise any 101 and 112(1) issues, it is clear that important steps are missing from the claimed invention so as to help one having ordinary skill in the art understand and practice the invention. Second of all, the term equipment is herein given a broad interpretation and may be replaced with product. Third of all, Lemole does teach a system wherein a user's demographic and psychographic profile and data associated with web sites previously visited by the user and ads previously seen by the user can be used to present customized or personalized advertisements on products (equipments), such as cars, TVs, computers, etc., or services to the user, thereby making sure that the user will be interested in reading these advertisements or even purchasing products associated with these customized advertisements that are specifically directed to his attention, especially the user is being incentivized to perform an action, such as buying a product or equipment subsequent to reading a customized advertisement (See discussion on claim 1 below).

Finally, contrary to the Applicant's arguments and in response to Applicant's request, a user using PC 101 may conduct an online transaction, such as the purchase of tickets or video tapes, with an advertiser such as Delta Airlines 116 or Disney World, as understood by those skilled in the art. Lemole et al. expressly disclose a system wherein a user receives an incentive, such as reduced Internet service charges from his ISP, or a discount on advertised product,

Art Unit: 3622

redeemable only at a specific site during an online purchase that includes the product having the discount, in an effort to encourage the user to visit the CAR service. It is to be understood that the user's transaction at the specific site will be used to further present customized advertising involving products or equipments or services to the user (col. 3: 55-62; col. 4: 4-10; col. 4: 59 to col. 5: 66).

Therefore, Applicants' arguments, as described herein, are not plausible and the Applicants' request for allowance has been respectfully denied. The previous office action rejection is maintained and the present action, as submitted below, **has been made final**.

#### **DETAILED ACTION**

##### **Status of the claims**

Claims 1-9 are now pending. Claim 1 was amended after the first Office Action.

##### ***Specification***

##### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Lemole et al, US Patent 6,009,410.

The applied reference, based upon its earlier effective U.S. filing date, constitutes a prior art under 35 U.S.C.102(e).

As per claim 1, Lemole et al teach a Customized Advertising Repository (CAR) Server 111 of fig.1 connected to the World Wide Web (Internet) 103 of fig.1 accessed by a registered user through his browser using client PC 101 of fig.1 (see abstract). When a registered user can enter a commercial context mode from information seeking work context mode by clicking on an icon or inputting the URL address of the particular CAR server, which stores his customized advertising repository. Upon accessing his customized advertising repository (CAR) via the browser of his computer 101 of fig.1, a composite advertising page or pages, in the form of static images, banners, animation, video and audio clips, is dynamically configured by the CAR Server 111 of fig.1 for that specific user based on that user's demographic and psychographic data provided during registration to the service (CAR) and context dependent basis from previously visited Web sites prior to accessing the service. The user, from such dynamically configured

Art Unit: 3622

composite page or pages, can then click on a particular image, video window or banner to visit a Web site associated with a particular advertiser's (116-121 of fig.1) such as Delta Airlines 116 of fig.1 engaging in commercial activities such as selling tickets to On-line surfers (see abstract-col.4, line 59 to col.5 line 22).

Furthermore, a user using PC 101 may conduct an online transaction, such as the purchase of tickets or videotapes, with an advertiser such as Delta Airlines 116 or Disney World, as understood by those skilled in the art. Lemole et al. expressly disclose a system wherein a user receives an incentive, such as reduced Internet service charges from his ISP, or a discount on advertised product, redeemable only at a specific site during an online purchase that includes the product having the discount, in an effort to encourage the user to visit the CAR service. It is to be understood that the user's transaction at the specific site will be used to further present customized advertising involving products or equipments or services to the user (col. 3: 55-62; col. 4: 4-10; col. 4: 59 to col. 5: 66).

As per claims 2, 3 and 4, Lemole et Al teach a plurality of vendors or suppliers or retailers or service providers or advertisers (116-121) connected to the CAR Server 111 of fig.1 via the HTTP Server 110 of fig.1 over the Internet 103 of fig.1 and, engaging in a plurality of on-line commercial activities (see fig.1). A vendor or retailer such as Delta Airlines 116 of fig.1 will use a user's profile data to offer a customized package deal to the user using client 101 of fig.1 connected to the Internet 103 of fig.1 (col.4, line 59 to col.5 line 22). If the user makes a purchase as a result of the package deal offer, the CAR service will automatically update his composite page or pages next time he uses the service.

As per claims 5-9, Lemole et al teach a method comprising the steps of:

5.      Wherein the merchandise **or product or service** is capable of being customized according to a specification from the retailer **such as Delta Airlines 116 of fig.1 that can put together a package deal for a user of the service based upon the users profile data** (col.4, line 59 to col.5, line 22).
6.      Wherein the merchandise is capable of being customized according to input from the customer **such as demographic and psychographic data provided by the customer during registration** (col.4, line 59 to col.5 line 22-see abstract).
7.      Wherein the customizing comprises individualizing a home page or **composite page or pages** for the customer (see abstract).
8.      Wherein the individualizing comprises creating an advertisement **banner or video/audio clips associated** with a specific retailer and stored in **Database 113 of fig.1 and accessed by the user upon entering the commercial context** (see abstract).
9.      Wherein the advertisement is user-interactive **since the user, while viewing a banner Ad. associated with a particular advertiser, can click on an associated link to visit the retailer's or advertiser's site for more information** (see abstract).

### Conclusion

Although the following references were not officially used in the office action, they were considered as relevant prior art. Applicant is further directed to review these references.

US Patent 5, 649, 114 to Deaton discloses a patronage incentive system wherein a customer's transaction history is used to provide incentives or coupons, redeemable on specific products, to the customer.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.



Art Unit: 3622

For information on the status of your case, please call the help desk at (703) 308-1113. Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

**Please provide support, that is page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.**

JDJ  
09/30/02



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